UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,486	02/11/2002	John R. Martin	13267US02	6208

7590 01/22/2009

John J. Held
McAndrews, Held & Malloy, Ltd.
34th Floor
500 West Madison Street
Chicago, IL 60661

EXAMINER	
FISCHER, ANDREW J	
ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
01/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. MARTIN and PATRICK G. RICE

Appeal 2008-3406
Application 10/073,486
Technology Center 3600

Decided: January 22, 2009

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and DAVID B. WALKER, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

John R. Martin and Patrick G. Rice (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-20, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

The Appellants invented a combination jukebox and electronic game (Specification 2:15-18).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

> 1. An entertainment system comprising:
> [1] a game subsystem;
> [2] a jukebox subsystem; and
> [3] a single control subsystem coupled to the game subsystem and the jukebox subsystem,
> [4] the control subsystem and the game subsystem providing game functionality, and
> [5] the jukebox subsystem and the control subsystem providing jukebox functionality,
> [6] the control subsystem exercising control over the game subsystem and the jukebox subsystem.

This appeal arises from the Examiner's Final Rejection, mailed August 23, 2006. The Appellants filed an Appeal Brief in support of the appeal on May 15, 2007. An Examiner's Answer to the Appeal Brief was mailed on September 24, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Miguel	US 5,971,397	Oct. 26, 1999
Shteyn	US 6,163,817	Dec. 19, 2000

REJECTIONS

Claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Shteyn.

Claims 4, 9, 12, 15, and 18-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Shteyn and Miguel.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over Shteyn.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 4, 9, 12, 15, and 18-20 under 35 U.S.C. § 103(a) as unpatentable over Shteyn and Miguel.

The pertinent issue turns on whether it was predictable to include both a jukebox and electronic game in a home theater system.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of "game."

02. The ordinary and customary meaning of "game" as a noun is an activity providing entertainment or amusement.[1]

Shteyn

03. Shteyn is directed to an information processing system with first and second electronic sub-systems and control. A software representation uses an abstraction of the sub-system for representing the respective sub-system at a semantic level common to the representations of the sub-systems controlled through respective software representations. (Shteyn 2:32-45).

04. Shteyn describes how an all-digital multimedia system with digital audio and digital video opens up new possibilities to the consumer, including real time video processing, and how multiple digital resources are going to be interrelated and integrated within a single home system (Shteyn 1:17-27).

05. In a home theater environment, Shteyn's sub-systems may be display devices, VCR's, TV tuners, radio tuners, audio amplifiers, DVD players, a CD jukebox, a digital video camera, a home security system, among others. Shteyn uses the abbreviation "etc." implying this is not an exhaustive list. Shteyn's control means may be a PC or a home theater, or even a server (Shteyn 4:4-17).

06. The application running on Shteyn's control means enables sub-systems to cooperate in a coordinated and fully automated manner through their software representations (Shteyn 4:18-20).

Miguel

07. Miguel is directed to a league and tournament system that is particularly adapted to using electronic dart machines (Miguel 3:1-8).

---

[1] *American Heritage Dictionary of the English Language* (4th ed. 2000).

08. Miguel describes how, as the choice of games to play on electronic dart machines has continued to increase, the user interface necessary to permit selection and set-up of those games has become more complicated and burdensome for the player (Miguel 2:37-40).

Facts Related To The Level Of Skill In The Art

09. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, home entertainment systems design, video game design, or control systems design. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'") (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

10. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill

in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that the obviousness analysis is bottomed on several basic factual inquiries: "[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved." 383 U.S. at 17. *See also KSR*, 127 S. Ct. at 1734. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 1740.

"For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.*

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742.

ANALYSIS

Claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 rejected under 35 U.S.C. § 103(a) as unpatentable over Shteyn.

The Appellants argue these claims as a group. Accordingly, we select claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Examiner found that Shteyn described all the limitations in claim 1 except for explicitly describing an electronic game. The Examiner found that Shteyn described using any electronic subsystem, including a jukebox or any software application, in its system and thus concluded that such any system would be an obvious variation of the claim limitations.

The Appellants contend that Shteyn does not list an electronic game and because Shteyn lists several examples, the fact that an electronic game is not among them indicates that Shteyn did not contemplate an electronic game (Br. 3-4). The Examiner responds it would be impractical for Shteyn to list every possible system that it might incorporate.

We agree with the Examiner. First, we construe the term "game" which is not defined in the Specification (FF 01). The usual and customary meaning is an activity providing entertainment or amusement (FF 02). Second, we find that the only contention by the Appellants is that Shteyn fails to describe including a game in its system. There is no contention as to the jukebox or control subsystem and the operation of the control subsystem over other subsystems. Accordingly, the only issue is whether it was predictable to one of ordinary skill to include a game subsystem in Shteyn.

Shteyn describes a home theater (FF 05). A home theater is designed to provide entertainment and amusement. Shteyn also describes its application to all digital multimedia systems (FF 04). Shteyn lists several types of sub-systems that may be controlled. Although Shteyn does not list a game among those examples, Shteyn implies the list is not exhaustive (FF 05). Shteyn controls the sub-systems via software (FF 06).

The issue then is whether one of ordinary skill would have found a game to be a predictable species of the Shteyn's sub-systems. We find that one of ordinary skill would have so found. Shteyn's reference to a multimedia system clearly suggests the system was for entertainment. Shteyn's usage of PC's and software to control the sub-systems and Shteyn's reference to digital sub-systems suggests sub-systems that are controlled by software. We find that one of ordinary skill would have immediately viewed games as a prototypical species of digital entertainment devices controllable by software. There is nothing about games that would have suggested that Shteyn's system would not be useful toward them.

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR, 127 S. Ct. at 1740.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over Shteyn.

Claims 4, 9, 12, 15, and 18-20 rejected under 35 U.S.C. § 103(a) as unpatentable over Shteyn and Miguel.

The Appellants argue claims 4 and 18. Claim 4 further requires a dart game and claim 18 is an independent claim requiring that the game, jukebox,

and control be within a single unit. The remaining claims 9, 12, and 15 stand or fall with claim 4 and claims 19-20 with claim 18.

As to claim 4, the Examiner found that Miguel described a dart game and that one of ordinary skill would have incorporated it in Shteyn to minimize the number of components (Answer 5-6). The Appellants contend that Miguel's game is not connected to a jukebox and such a combination does not describe a single control subsystem (Br. 10-11). We disagree with the Appellants. The Appellants are arguing that Miguel does not describe those claim limitations for which Shteyn is applied. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Miguel simply provides evidence that a dart game was known to those of ordinary skill in digital entertainment, and we already found *supra* that it would have been obvious to include a game in Miguel's system. To defeat obviousness when claiming a subset of a range disclosed in a prior art patent, one generally must show that "the claimed range achieves unexpected results relative to the prior art range." *See In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990). The Appellants have made no showing of unexpected results for dart games in particular.

As to claim 18, the Examiner found that one of ordinary skill would have known to include the components in a single unit to conserve space (Answer 6-7). The Appellants contend that claim 18 is directed to three components in a single unit that were not previously in a single unit (Br. 15). We disagree with the Appellants. Nothing in Shteyn states that the subsystems are in separate units. To the contrary, Shteyn states that multiple

digital resources are going to be interrelated and integrated within a single home system. The claim does not limit the nature of the unit. Thus, a home that encapsulates a home system would be a single unit that contained all the components of Shteyn's system.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 4, 9, 12, 15, and 18-20 under 35 U.S.C. § 103(a) as unpatentable over Shteyn and Miguel.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims under 35 U.S.C. § 103(a) as unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over Shteyn is sustained.
- The rejection of claims 4, 9, 12, 15, and 18-20 under 35 U.S.C. § 103(a) as unpatentable over Shteyn and Miguel is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED

hh

John J. Held
McAndrews, Held & Malloy, Ltd.
34th Floor
500 West Madison Street
Chicago, IL 60661